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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,799	01/09/2002	Michael E. Tompkins	BALIN-59231	1955

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EXAMINER	
VON BUHR, MARIA N	

ART UNIT	PAPER NUMBER
2125	7

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No.	Applicant(s)	
	10/043,799	TOMPKINS ET AL.	
	Examiner	Art Unit	
	Maria N. Von Buhr	2125	

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 Jan 2002, 11 Mar 2002, 01 Jul 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. This application is a continuation of Serial No. 09/761,264, which is a continuation of Serial No. 08/822,179, which is a continuation of Serial No. 08/703,177, which is a continuation of Serial No. 08/327,927, which is a continuation of Serial No. 08/225,282, which is a continuation of Serial No. 07/224,869, filed July 26, 1988, which is a continuation-in-part of Serial No. 07/054,581, filed May 27, 1987. Accordingly, this application is accorded the benefit of the earlier filing date of July 26, 1988 for all the instantly disclosed subject matter added in Serial No. 07/224,869, and the earlier filing date of May 27, 1987 for all instantly disclosed subject matter originally presented. Any previously presented rejections or objections which are not expressly repeated in this Office action are hereby withdrawn.

2. Examiner acknowledges receipt of Applicant's preliminary amendment, received January 9, 2002; which amends the specification, cancels claims 1-34 and introduces claims 35-72. Claims 35-72 are now pending in this application.

3. Examiner acknowledges receipt of Applicant's information disclosure statement, received July 1, 2002, with accompanying reference copies, which have been taken into consideration for this Office action.

4. The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

5. Claim 72 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, since there is no antecedent basis for "the means for converting."

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR §1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR §1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR §3.73(b).

7. Claims 35-41, 45, 46, 50, 51, 54-60, 64, 65, 69 and 70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5 and 9 of U.S. Patent No. 6,253,227. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the "pump" and/or "third sensor" limitations, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. Also, as per the instantly claimed limitations concerning an "electrical power source," the presence of such an element would inherently have been necessary, else the system would not have been operational. Hence, such a limitation is deemed not to be patentably distinguishing.

8. Claims 35-52 and 54-71 are rejected under the judicially created doctrine of double patenting over claim of U. S. Patent No. 5,361,215, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: as per claims 1, 2, 4, 6, 7, 18-21, 24-29, 39 and 48 of the patent, a spa controller with two sensors, a controlling element, and a power source for a heating element.

Furthermore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP §804.

9. Claims 35-43, 45, 46, 50, 51, 53-62, 64, 65, 69, 70 and 72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14, 29, 30, 35, 39 and 40 of U.S. Patent No. 5,559,720. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the "pump" limitations, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. Also, as per the instantly claimed limitations concerning an "electrical power source," the presence of such an element would inherently have been necessary, else the system would not have been operational. Hence, such a limitation is deemed not to be patentably distinguishing.

10. Claims 35-43, 46, 50, 51, 54-62, 65, 69 and 70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,550,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because, as per the instantly claimed limitations concerning an "electrical power source," the presence of such an element would inherently have been necessary, else the system would not have been operational. Hence, such a limitation is deemed not to be patentably distinguishing.

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. **Any response to this Office action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to the Office at:
(703) 746-7239 - for formal communications intended for entry, mark "FORMAL";
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

MARIA N. VON BUHR
PRIMARY PATENT EXAMINER
ART UNIT 2125

MNVB
12/10/03